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1652

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Harrington, et al.

Serial No.: 08/951,733

Group Art Unit No.: 1652

Filed: October 16, 1997

Examiner: G. Bugaisky

For: NOVEL GENES ENCODING TELOMERASE
PROTEINS

Docket No.: A-433B

#10
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10-24-98

COMMUNICATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In the Communication mailed 22 September 1998 for the referenced patent application, the Examiner imposed a restriction requirement, asserting that claims 1-21 and 26-30 comprise invention I, and claims 22-25 and 31-32 comprise invention II.

The Examiner cites MPEP § 806.05(f) in support of this position, asserting that inventions I and II are related as process of making and product made.

In response, Applicants elect invention I, claims 1-21 and 26-30, with traverse, for the following reasons. MPEP § 806.05(f) is titled "Process of Making and Product Made - Distinctness". The Examiner suggests that invention I is "Process of Making" and invention II is "Product Made". Applicants respectfully point out that invention I contains 26 claims. Of these, claims 1-19 and 29-30 are composition of matter claims, not "process of making claims"; thus 21 of 26 claims, or 80 percent of the claims, are not "process of making claims".

As such, Applicants submit that the limitations set forth in MPEP § 806.05(f) are not applicable, and the restriction requirement is in error. Further, MPEP § 806.04 states that:

"Two different combinations, not disclosed as capable of use together... are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example." (emphasis added).

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231, on the date appearing below.

October 16, 1998

Date

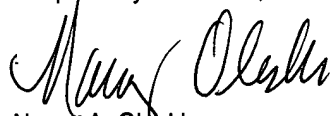
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Signature

"Where the inventions claimed are independent, i.e., where they are not connected in design, operation, or effect under the disclosure of the particular application...the facts relied on...are the reasons for insisting upon restriction. This situation, except for species, is but rarely presented, since persons will seldom file an application containing a disclosure of independent things." (emphasis added).

Applicants' invention is directed to the discovery of a new class of mammalian genes and to the proteins encoded by these genes. Applicants maintain that this discovery comprises a single unified invention. The protein is preferably prepared using the gene; hence, the gene and protein are "capable of use together". Applicants teach as much in their specification. For example, on pages 82-84 of the specification there is a discussion of generating TP 2 polypeptides in human cells using TP 2 cDNA. Clearly then, the protein and gene of the present invention are connected and related. further, as pointed out in MPEP § 808.01, it is rare that an application discloses more than one invention. As such, Applicants believe that their claims in total are directed to a single invention, and that the restriction requirement is in error.

Should the Examiner wish to discuss this matter further, Nancy Oleski, attorney for the Applicants, can be reached by phone at (805) 447-6504.

Respectfully submitted,



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